



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,613	01/11/2002	Antonio T. Latto	INTL-0624-US (P11955)	9479

21906 7590 08/28/2006

TROP PRUNER & HU, PC
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

NGUYEN, THUAN T

ART UNIT	PAPER NUMBER
----------	--------------

2618

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/044,613	Applicant(s) LATTO ET AL.	
	Examiner THUAN T. NGUYEN	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Allowable Subject Matter

1. Claims 1-8 have been allowed.
2. The following is a statement of reasons for the indication of allowable subject matter: the prior arts of record do not teach or suggest a replaceable ornament insert for an electronic device as cited in claim 1, wherein the replaceable ornament insert is placed between a substantially transparent section of a removable faceplate and a first surface of the base of the electronic device, and the ornamental insert punched out of a sheet of paper after a user of the electronic device has printed an ornamental design thereon.

Claim Rejections - 35 USC 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slipy et al. (U.S. Patent No. 5,848,152) in view of Barnes et al. (US Patent 4,292,481).

Regarding claims 12, 15, and 17-19, Slipy discloses an electronic device and its corresponding method such as a portable telephone with a base having a first surface, and with a removable faceplate 104 for covering substantially all of the first surface of the device (see Fig. 2, and col. 5/line 40 to col. 6/line 15). Slip suggests that the faceplate 104 can be customized in any shape, any contour, size and color (col. 4/lines 12-60).

Slipy does not further disclose to include the faceplate is “transparent” or clear and “replaceable ornamental insert positionable between the removable faceplate and the first surface of the base such that a portion of the ornamental insert is viewable through the substantially transparent section”; however, this technique is taught by Barnes (see Abstract, and Figs. 1 & 4, a transparent cover with exchangeable decorative applique 64 on which designs can be printed for personalizing decorations, which also placed between the transparent cover and the surface of the base of the electronic device 10, refer to col. 4/lines 3-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Slipy’s interchangeable faceplate for covering substantially all of an electronic device with Barnes’ technique of using exchangeable inserts for decoration between the base of the electronic device and a transparent plastic cover in order to obtain an easy technique in decorations for an electronic device, with the exchangeable inserts as any decorative (desired) design, underneath a clear/transparent removable faceplate so that the user can view through the transparent faceplate.

As for claims 9-11, 13 and 20, Slipy and Barnes teaches this feature for applying this technique for an electronic device, wherein the electronic device now is a digital audio player, as a generalized procedure for applying the decoration inserts underneath the transparent removable faceplate to a digital audio player, same as discussed in claims 12-15, 17-19, and 21 above.

As for claim 14, Slipy and Barnes teaches this feature for applying this technique for an electronic device, wherein the base now is a base portion of a digital game player, as a generalized procedure for applying the decoration inserts underneath the transparent removable faceplate to a digital game player, same as discussed in claims 12-15, 17-19 and 21 above.

As for claim 16 and 21, Slipy and Barnes teaches this feature for applying this technique for an electronic device, wherein the base is now a base portion of a computer and/or a notebook computer, as a generalized procedure for applying the decoration inserts underneath a clear removable faceplate to a portable laptop computer, same as discussed in claims 12-15, 17-19 and 21 above.

In addition to claim 17, Slipy teaches a faceplate coupled to the base and the faceplate covering all of the upper surface of the base (Fig. 2 for the faceplate 104 cover all of the upper surface of the base or housing 102) and the faceplate having a substantially transparent section (as Slipy suggests to customize in any shape, contour, size or color as discussed above; and the teaching of Barnes for transparent/clear removable faceplate as above).

Response to Arguments

5. Applicant's arguments filed 05/30/06 have been fully considered but they are not persuasive. Applicants argue that for claims 9, 12, and 17, neither Slipy or Barnes mentions a digital audio player, a replaceable ornament insert, or a notebook computer etc., the examiner considers these features as well-known and even had been disclosed previously in earlier office actions, and now the examiner might take as an official notice as the prior art teaches to have cover for the electronic devices as a digital audio player or notebook computer as well as the replacement insert issue. If the applicants would love to challenge the examiner for a prior art, the examiner would then be gladly provide the prior art at a later time. Meanwhile, the claim languages do not appear in a better form in a condition for allowance, and the office action clearly supports the interpretation and understanding from the examiner for those claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to the New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)


Hand deliveries must be made to Customer Service Window,

Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony Thuan Nguyen whose telephone number is (571) 272-7895. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

Art Unit: 2618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TONY T. NGUYEN
PATENT EXAMINER, PA

Tony T. Nguyen
Art Unit 2685
February 13, 2006